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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/816,091	03/26/2001	Masashi Ota	109073	9597

25944 7590 06/05/2002

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EXAMINER

CHERRY, STEPHEN J

ART UNIT PAPER NUMBER

2863

DATE MAILED: 06/05/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/816,091

Applicant(s)

MASASHI OTA

Examiner

Stephen J. Cherry

Art Unit

2863

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on 14 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Specification***

The incorporation of essential material in the specification by reference to a foreign application or patent, or to a publication is improper. Applicant is required to amend the disclosure to include the material incorporated by reference. The amendment must be accompanied by an affidavit or declaration executed by the applicant, or a practitioner representing the applicant, stating that the amendatory material consists of the same material incorporated by reference in the referencing application. See *In re Hawkins*, 486 F.2d 569, 179 USPQ 157 (CCPA 1973); *In re Hawkins*, 486 F.2d 579, 179 USPQ 163 (CCPA 1973); and *In re Hawkins*, 486 F.2d 577, 179 USPQ 167 (CCPA 1973).

### ***Information Disclosure Statement***

The information disclosure statement filed 6-14-2001 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. It has been placed in the application file, but the information referred to therein has not been considered.

### ***Claim Objections***

Claim 3 is objected to because of the following informalities: The claim refers to a certain driving device, but does not disclose what the device is. Appropriate correction is required

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-10 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S.

Patent 4,787,050 to Suzuki. The claims describe, as disclosed by Suzuki, determining if at least a predetermined manufacturing program out of a plurality of manufacturing programs corresponding to the plurality of manufacturing processes has been executed ('050, S100), storing the number of operations executed for manufacturing the products according to the predetermined manufacturing program, when it is determined that the predetermined manufacturing program has been executed ('050, S110), outputting the stored number of operations executed for manufacturing the products according to the predetermined manufacturing program ('050, S150), the determining step comprises a program for determining if the predetermined manufacturing program has been executed, together with the plurality of manufacturing programs, or independently therefrom ('050, Fig. 4A), detecting operation of a certain driving device operated according to the predetermined manufacturing program; and outputting a predetermined signal, on the basis of which it is determined if the predetermined manufacturing program has been executed ('050, 9 and 11), a program for determining if the predetermined manufacturing program has been executed, together with the plurality of manufacturing programs, or independently

therefrom, and wherein the storing step comprises: storing the number of operations executed for manufacturing the products according to the predetermined manufacturing program, when it is determined that the predetermined manufacturing program has been executed according to the determining program, and determined that the predetermined manufacturing program has been executed on the basis of the output signal ('050, S120), transmitting the stored number of operations to a communication infrastructure ('050, M3), determination means for determining if at least a predetermined manufacturing program out of a plurality of manufacturing programs corresponding to the plurality of manufacturing processes has been executed ('050, S100), storage means for storing the number of operations executed for manufacturing the products according to the predetermined manufacturing program, when the determination means determines that the predetermined manufacturing program has been executed ('050, S110), output means for outputting the number of operations executed for manufacturing the products according to the predetermined manufacturing program stored in the storage means ('050, S150), the determination means comprises a program for determining if the predetermined manufacturing program has been executed, together with the plurality of manufacturing programs, or independently therefrom ('050, Fig. 4A), detection means for detecting operation of a certain driving device operated according to the predetermined manufacturing program, and outputting a predetermined signal, and wherein the determination means determines if the predetermined manufacturing program has been executed, on the basis of the signal output from the detection means ('050, 9 and 11), the determination means comprises a

program for determining if the predetermined manufacturing program has been executed, together with the plurality of manufacturing programs, or .. Independently therefrom, and wherein the storage means stores the number of operations executed for manufacturing the products according to the predetermined manufacturing program, when the determination means determines that the predetermined manufacturing program has been executed according to the determining program, and determines that the predetermined manufacturing program has been executed on the basis of the signal output from the detection means ('050, S120), communication means for transmitting the output of the output means to a communication infrastructure, to which the number of operations stored in the storage means is transmitted ('050, M3).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki in view of U.S. Patent 5,925,127 to Ahmad. The claims describe, as anticipated by Suzuki determination means for determining if at least a predetermined manufacturing program out of a plurality of manufacturing programs corresponding to the plurality of manufacturing processes has been executed ('050, S100), storage means for storing the number of operations executed for manufacturing the products

according to the predetermined manufacturing program, when the determination means determines that the predetermined manufacturing program has been executed ('050, S110), output means for outputting the number of operations executed for manufacturing the products according to the predetermined manufacturing program stored in the storage means ('050, S150). The claims further describe a license agreement for copyrighted software, not implicitly disclosed by Suzuki. Ahmed discloses the use of a use accounting system for software that is licensed and contains "know how", as described in the claim. Thus, it would have been obvious to one of ordinary skill to combine the invention of Suzuki with the invention of Ahmed to allow the manufacture of more types of software.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen J. Cherry whose telephone number is (703) 305-0425. The examiner can normally be reached on M-F 8:00-4:30.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John S. Hilten can be reached on (703) 308-0719. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-4402 for regular communications and (703) 746-4402 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0719.

Application/Control Number: 09/816,091  
Art Unit: 2863

Page 7

SJC  
June 3, 2002



**JOHN S. HILTEN**  
**SUPERVISORY PATENT EXAMINER**  
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